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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/821,963 | 04/12/2004 | Hiroya Kumashio | 251606US-2CONT | 2374 |
| 22850 | 7590 | 10/04/2006 | EXAMINER | |
| C. IRVIN MCCLELLAND OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | NGUYEN, MERILYN P | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2163 | |

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/821,963

Applicant(s)

KUMASHIO, HIROYA

Examiner

Merilyn P. Nguyen

Art Unit

2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

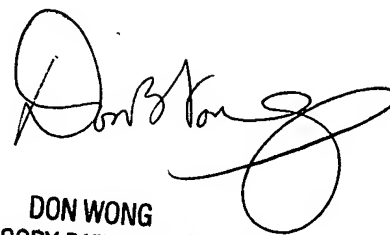
- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/632212.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input checked="" type="checkbox"/> Other: <u>Detailed action</u> . |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :05/07/04,07/12/04,04/06/06,08/14/06.



DON WONG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

DETAILED ACTION

1. Claims 1-18 are pending in this action.
2. This application is a continuation of 09/632,212 (patent number 6,782,387). This application claims the priorities of Japanese Application No. 2000-229571 filed July 28, 2000, 11-353718 filed December 13, 1999, and 11-224015 filed August 06, 1999.

Drawings

3. Figures 1 and 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 3, 13 and 11-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 3 and 13, the claims recite "a display part configured to display data that **concerns the databases**" which renders the claims vague and indefinite. It's unclear what Applicant meant by "concerns the databases" (Emphasis added).

Regarding claims 11-18, the preamble of the claim recites, "a computer-readable recording medium including programs recorded therein", however, the body of the claim recites means plus function. Thus, it's unclear whether Applicant tried to claim a computer readable recording medium including instructions or tried to claim means plus function type of claim. Further more, the claim recites "wherein the means for connecting" which provides intended use and non-functional descriptive.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As set forth in MPEP 21 06(II)A:

Identify and understand Any Practical Application Asserted for the Invention The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d at 1373, 47USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383

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U.S. 519, 528-36, 148 USPQ 689, 693-96),¹ In re Ziegler, 992, F.2d 1 197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)34. Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful.

Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See Arrhythmia, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. For example, a claim directed to a word processing file stored on a disk may satisfy the utility requirement of 35 U.S.C. 101 since the information stored may have some "real world" value. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application.

The claimed invention is subject to the test of State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. Specifically State Street sets forth that the claimed invention must produce a "useful, concrete and tangible result". The Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility states in section IV C. 2 b. (2) (on page 21 in the PDF format):

The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a §101 judicial exception, in that the process claim must set forth a practical application of that §101 judicial exception to produce a real-world

result. Benson, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had "no substantial practical application").

Claimed invention (Claim 1) recites "an integrating document management system comprising: connecting parts configured **to connect a user interface part to a plurality of data processing parts**, and configured **to implement common document management operations** upon a plurality of databases, wherein the connecting parts include respective interfaces that correspond to respective ones of the databases and include common interfaces that correspond to the user interface part." However, the connecting parts, user interface part and data processing parts are constructed without indications of the practical application to product useful and real world results. There are no real world outcomes of how connecting parts connect with user interface part and data processing parts applied on integrating documents of the plurality of databases.

Claimed invention (Claim 9) recites "an information processing apparatus comprising: connecting parts configured **to connect a user interface part to a plurality of data processing parts**, and configured **to implement common document management operations** upon a plurality of databases, wherein the connecting parts include respective interfaces that correspond to respective ones of the databases and include common interfaces that correspond to the user interface part." However, the connecting parts, user interface part and data processing parts are constructed without indications of the practical application to product useful and real world results. There are no real world outcomes of how connecting parts connect with user interface part and data processing parts applied on integrating documents of the plurality of databases.

Claimed invention (Claim 11) recites “**A computer-readable recording medium including programs recorded therein, the programs causing a computer to function as: means for connecting a means for providing a user interface to a plurality of means for processing data, wherein the means for connecting includes respective interfaces that correspond to respective ones of a plurality of databases and include common interfaces that correspond to the means for providing a user interface, and wherein the means for connecting is configured to implement common document management operations upon the databases.**” However, the claim does not provide practical application because it does not produce useful real world value or results. For example, means for connecting simply implement common document management operations upon the database without providing the real world outcomes from it or without disclosing the whole purpose of the invention.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned

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with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-18 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,782,387. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are substantially similar in scope and they use the similar limitations.

Regarding claims 1-2 and 9-12 of the instant application, these claims recite the broader version of claims 1, 7, and 8 of the '387. Claims 1, 7, and 8 of the '387 also includes additional elements that are not recited in the instant claims.

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to omit the additional elements of claims 1, 7, and 8 of the '387 to arrive at the claims 1-2 and 9-12 of the instant application because the one would have realized that the remaining element would perform the same functions as before. "omission of element and its function in combination is obvious expedient if the remaining elements perform same functions as before."

See *In re Karlson* (CCPA) 136 USPQ 184, decide Jan 16, 1963, Appl. No. 6857, U.S. Court of Customs and Patent Appeals.

The subject matter of claims 3-8 and 13-18 of the instant application are same as claims 2-6 and 9-14 of the '387.

Following is the chart of corresponding claims rejected under double patenting rejection between instant application and the U.S. Patent No. 6,782,387.

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| <u>Instant Application</u> | <u>6,782,387</u> |
|----------------------------|------------------|
| 1+2 | 1 |
| 3 | 2 |
| 4 | 10 |
| 5 | 3 |
| 6 | 4 |
| 7 | 5 |
| 8 | 6 |
| 9+10 | 7 |
| 11+12 | 8 |
| 13 | 9 |
| 14 | 10 |
| 15 | 11 |
| 16 | 12 |
| 17 | 13 |
| 18 | 14 |

The subject matter of claims 2, 3, 5, 7-10, and 18-20 of the '686 application are same as claims 2, 3, 5, 7-10, and 18-20 of instant application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Sziklai (US 6,341,287).

Regarding claims 1, 9 and 11, Sziklai discloses an integrating document management system, an information processing apparatus and a computer-readable recording medium including programs recorded therein comprising: connecting parts configured to connect a user interface part to a plurality of data processing parts (See col. 15, lines 48-51 and col. 29, lines 19-30), and configured to implement common document management operations upon a plurality of databases (See col. 17, line 9 to col. 22, line 20), wherein the connecting parts include respective interfaces that correspond to respective ones of the databases and include common interfaces that correspond to the user interface part (See col. 11, lines 2-7, 56-67 and col. 15, lines 60-65, Figs. 8 and 9 shows example of connecting to product stewardship database which having a respective interface).

Regarding claims 2, 10 and 12, Sziklai discloses the databases (See col. 8, lines 25-27), wherein the data processing parts are configured to process data of the respective ones of the

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databases (See col. 17, line 9 to col. 22, line 20), and wherein the user interface part is configured to provide an interface for a user (See col. 11, lines 2-5).

Regarding claims 3 and 13, Sziklai discloses a display part configured to display data that concerns the databases (See Fig. 8); and an instructing part configured to allow the user to give processing instructions for data of the databases (See Fig. 8).

Regarding claims 4 and 14, Sziklai discloses wherein the connecting parts include a standardized interface configured to communicate with the user interface part (See Fig. 8 and col. 11, lines 56-67).

Regarding claims 5 and 15, Sziklai discloses wherein the user interface part performs connection and disconnection of the connecting parts (See col. 29, lines 19-30).

Regarding claims 6 and 16, Sziklai discloses wherein the user interface part obtains information from the connecting parts that indicates whether or not processing instructions are supported or allowed by the respective ones of the databases (See Fig. 8, “you are now connected to product stewardship”).

Regarding claims 7 and 17, Sziklai discloses wherein the user interface part uses graphic items that represent data of the databases (See Fig. 8, icons).

Regarding claims 8 and 18, Sziklai discloses wherein the user interface part obtains graphic data used to display the graphic items from the connecting parts (See Fig. 9).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Carhart U.S Patent No. 5,511,186 discloses system and methods for performing multi-source searches over heterogeneous databases.

Sarkar US Patent No. 6,418,448 discloses method and apparatus for processing markup language specifications for data and metadata used inside multiple related internet documents to navigate, query and manipulate information from a plurality of object relational databases over the web.

Clegg U.S Patent No. 6,356,946 discloses system and method for serializing java objects in a tubular data stream.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Merilyn P Nguyen whose telephone number is 571-272-4026. The examiner can normally be reached on M-F: 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and 703-746-7240 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.


MN

September 27, 2006